



UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 26

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AUG 20 2003

In re Application of:	:	
HOUSTON, THEODORE W.	:	DECISION TO WITHDRAW
Application No. 09/346,436	:	HOLDING
Filed: July 01, 1999	:	OF ABANDONMENT
Attorney Docket No.: TI-21004	:	

This is a decision on the request filed March 04, 2003, to withdraw the holding of abandonment for the above identified application under 37 CFR 1.181 for which no fee is required.

The petition is **granted**.

A Reply Brief in response to the Examiner's Answer of August 22, 2001, was timely filed on October 18, 2001. In response to the Reply Brief filed October 18, 2001, the examiner reopened prosecution and mailed a final rejection on January 07, 2002. On April 05, 2002, a supplemental Appeal Brief was filed. In response to the Supplemental Appeal Brief, a "NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(c)" (hereinafter NOTIFICATION) was mailed on May 20, 2002. On September 27, 2002, the office re-mailed and reset the period for response for the NOTIFICATION of May 20, 2002, because the petitioner had not received the NOTIFICATION. On October 07, 2002, a response to the NOTIFICATION was filed. On October 23, 2002, a Substitute Supplemental Appeal Brief was filed. On January 29, 2003, the appeal was dismissed and the application was held abandoned because there were no allowed claims.

Petitioner asserts that the application was erroneously abandoned because a proper Notice of appeal was filed as to claims 1 to 4, 7 to 9 and 18 to 24. Further, the petitioner attests that claims 1 to 4, 7 to 8, 18 to 21, 23 and 24 were dropped with respect to the appeal and as such, the petitioner has chosen not to contest the rejection of these claims.

A review of the application file reveals that the NOTIFICATION indicated that the "indication of claims pending in the application is uncertain because it is unclear if, in fact, claims 1, 3, 7, 8, 18-21, 23, and 24 are canceled. Further, the Supplemental Appeal Brief in response to this Office Action must either address claims 2 and 4 or be accompanied by an amendment canceling

claims 2 and 4.” The petitioner responded with a Substitute Supplemental Appeal Brief that reinstated the Reply Brief of October 18, 2001 and reiterates that “all claims have been canceled by not having been appealed with the exception of claims 9 and 22, which remain on appeal and claims 25 and 26 which have been stated to be allowable if independently presented, this appeal only involves claims 9 and 22.” Upon receipt of the apparent unsatisfactory response to the NOTIFICATION, the application was held abandoned. The Notice of Abandonment indicates that the Appeal Brief is defective because “it is unclear if, in fact, claims 1-4, 7, 8, 18-21, 23 and 24 were canceled since no proper amendment canceling the claims was made.”

MPEP 1215.03 states the following:

**1215.03 Partial Withdrawal**

A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application or reexamination proceeding and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner at the conclusion of the appeal proceedings, if necessary (e.g., the examiner is reversed as to the rejection of the remaining claims on appeal), without further action by the applicant.

In view of the above, it is clear that when claims are withdrawn from consideration, they are, in effect, canceled from the application and the appeal continues as to the remaining claims. Accordingly, the examiner’s assertion that the Appeal Brief is defective because it is unclear if some of the claims were canceled, since no proper amendment canceling the claims was made, is inaccurate. It is clear from the Reply Brief filed October 18, 2001 and the subsequent Substitute Supplemental Appeal Brief filed October 23, 2002, that the petitioner has, with the exception of claims 9, 22, 25 and 26, withdrawn all the remainders of the claims<sup>1</sup> from consideration. And as such, only rejected dependent claims 9 and 22 are the subject of the appeal for the above identified application. As a result, the examiners assertion with regards to the cancelation of the claims in the NOTIFICATION were inappropriate since withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application proceedings.

For the above stated-reason, the petition is **granted**.

The Notice of Defective Appeal Brief and the Notice of Abandonment are hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The application file is being forwarded to the examiner for appropriate action.

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<sup>1</sup>The petitioner addresses claims 2 and 4 in his response to the NOTIFICATION filed October 07, 2002. Accordingly, the status of all the claims has been addressed by the petitioner.

Inquiries regarding this decision should be directed to Lissi Mojica Marquis at (703) 308-2260.



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